SUPREME COURT, U. S.

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E. ROBERT SEAVER, C.

No. 71-967

In the
Supreme Court of the United States
OCTOBER TERM, 1971

EUGENE A. WAHL and
VIBRA SCREW FEEDERS, INC.,
Petitioners,

vs.

CARRIER MANUFACTURING CO., INC.,
Respondent.

REPLY BRIEF OF PETITIONERS IN SUPPORT OF THE PETITION FOR THE WRIT OF CERTIORARI

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Respondent does not dispute that the District Court construed the same claims of the patent in suit one way for purposes of novelty and another for purposes of infringement or that the Court of Appeals approved of this diverse claim interpretation.

Neither does Respondent dispute the importance that uniform interpretation of patent claims has to the respective rights of the public and patentees.

Respondent argues (Brief, p. 6) that consistent claim interpretation is not an important issue because it "was completely and adequately resolved by the trial court

based upon a conflict of testimony as to the scope of the claims in the light of the prior art presented."

This only magnifies the importance of the first question presented by the Petition. Is there not even greater urgency for this Court to speak on the question when lower courts are of the view that the interpretation of patent claims is not a legal but a factual matter to be resolved by weighing the testimony of witnesses and, further, that diverse interpretations of the same claims are permissible when the testimony directed to them on the validity issue is inconsistent with that on the infringement issue?

Respondent in its response to the second reason urged by the Petition for granting the Writ does not contend that the District Court found the differences between the prior art and the claims at issue as required by Section 103 of the Patent Act and the decision in *Graham* v. *John Deere*, 383 U.S. 1. Instead, Respondent argues that it was unnecessary to do so because of the findings that the claims in suit were anticipated.

The *Graham* decision gives no indication that obviousness can be determined other than by strict observance of the requirements of the statute. Had the factual inquiries required for the obviousness issue been made in the instant case the trial court would have discovered that on the anticipation issue it had: (1) broadened the claims beyond their terms and even beyond the scope of the subject matter of the specification of the patent, and (2) that the prior art which the claims were broadened to encompass was concerned with devices which operated only after the problem to which the patent in suit is directed had ceased to exist. It would also have been

discovered that such prior art further differed from the claimed subject matter in that it did not respond to clear limitations in the claims, including one inserted after rejection of broader claims by the Patent Office.

Respondent points also to conclusionary findings made by the District Court on the issue of obviousness. This is no answer. This Court, in *Graham*, pointed out that "several basic factual inquiries" must be made as a basis for a conclusion on obviousness. One of them is the "differences between the prior art and the claims at issue." (383 U.S. at 17).

The mandate of *Graham* is eroded if conclusions are to be substituted for such "basic factual inquiries" and subjective tests, such as alleged independent development, are to be permitted as a basis for determining obviousness. Clearly the interposition of this Court is required.

Respectfully submitted,

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